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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,098	12/21/2005	George Henry Platt Brown	UDL1P017/RMV/jwa/P400715U	9493
28875	7590	02/13/2008		
Zilka-Kotab, PC P.O. BOX 721120 SAN JOSE, CA 95172-1120			EXAMINER NGUYEN, CHAU N	
			ART UNIT 2831	PAPER NUMBER
			MAIL DATE 02/13/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/522,098

**Applicant(s)**

BROWN ET AL.

**Examiner**

Chau N. Nguyen

**Art Unit**

2831

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-32, 40 and 41 is/are rejected.
- 7) ☒ Claim(s) 33-39, 42 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 28-32, 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bottoms, Jr. et al. (5,274,725) in view of Szum (6,240,230).

Bottoms, Jr. et al. (Figures 1-3) discloses a signal transmitting cable comprising a first signal transmitting portion including a plurality of elongate, flexible first optical signal transmitting members (23), wherein the first signal transmitting members of the first signal transmitting portion are surrounded by a first layer of resin material (22) such that only the outermost signal transmitting members are in contact with said first layer (col. 4, lines 25-29 and col. 10, lines 30-40), and said first signal transmitting members are arranged to form at least three rows, wherein for each said row containing a plurality of said members, said members are arranged such that neighbouring members of said row are in touching contact with each other, each recess formed by neighbouring members of a first said row facing towards a second said row accommodates a respective member of said second row, and said first layer is in touching contact with substantially all of the outward facing surface of the first signal transmitting portion (re claim 28). Bottoms, Jr. et al. also discloses an outermost layer having an inner periphery longer than the outer periphery of the layer adjacent thereto to enable removal of the outermost layer from the cable (re claim 40). Bottoms, Jr. et al. does not disclose the first layer of resin material curable by means of radiation or cured by means of ultraviolet radiation (re claims 28 and 32). Szum discloses an ultraviolet radiation curable composition which is used for protecting and/or bonding optical

fibers within an optical fiber cable and which has sufficient no-yellowing together with sufficient cure speed. It would have been obvious to one skilled in the art to use the material as taught by Szum for the first layer material of Bottoms, Jr. et al. since the material taught by Szum is used for protecting and/or bonding optical fibers within an optical fiber cable and has sufficient no-yellowing together with sufficient cure speed. Claim 41 is a method counterpart of claim 28. Noted that the modified cable of Bottom, Jr. et al. can be used for installation into a tube by means of blowing by compressed fluid since it comprises structure and material as claimed.

Re claims 29-31, it would have been obvious to one skilled in the art to provide the first transmitting portion of Bottoms, Jr. et al. with 12, 18 or 24 transmitting members arranged in 4 or 5 rows having 2, 3, 4 & 3, or 2, 4, 5, 4 & 3, or 4, 5, 6, 5 & 4 configuration to increase the transmission capacity of the cable since it has been held that merely duplicating the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Allowable Subject Matter***

4. Claims 33-39, 42 and 43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

5. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection and the following response.

In response to applicant's argument that the Office Action has not established a *prima facie* case of obviousness, it has been held that the examiner's burden of establishing *prima facie* obviousness is satisfied by a showing of structural similarity between the claims and prior art; it does not require a showing of some suggestion or expectation in the prior art that the structurally similar subject matter will have the same or a similar utility as that discovered by the applicant. In re Dillon, 16 USPQ 2d 1897.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion is found in the references themselves. Specifically, Szum teaches the material being used for protecting and/or bonding optical fibers within an optical fiber cable and having sufficient no-yellowing together with sufficient cure speed.

In response to applicant's argument that the cable of Bottom, Jr. et al. would be unsuitable for installation into a tube by means of blowing by a compressed fluid, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant also argues that Figure 3B of Bottom, Jr. et al. fails to suggest that "the first optical signal transmitting members of the first signal transmitting portion are surrounded by a first layer of resin material.... such that only the outermost optical signal transmitting members are in contact with said first layer... and said first layer is in touching contact with substantially all of the outward facing surface of the first signal transmitting portion". Examiner disagrees. Bottom, Jr. et al.,

col. 4, lines 25-29, discloses that the strain jacket is extruded along the length and about the **circumference of a bundle** formed by the plurality of optical fibers. As shown in Figure 3B, the first optical signal transmitting members 23 are surrounded by the first layer of resin material 22, and the first layer is in touching contact with **substantially** all of the outward facing surface of the first signal transmitting portion.

### *Summary*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,



will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N. Nguyen whose telephone number is 571-272-1980. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutiérrez can be reached on 571-272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chau N Nguyen/

Chau N Nguyen  
Primary Examiner  
Art Unit 2831